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09/944,549	08/31/2001	Lou Chauvin	83304BF-P	3066

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/944,549

Applicant(s)

CHAUVIN ET AL.

Examiner

James S McClellan

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*MLW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5, 6, 12, and 17 are objected to because of the following informalities: failing to provide punctuation at the end of the claim (for example, insert a "." at the end of each claim).

Additionally, claim 22 is objected to because in line 9, "a" should be replaced with --at--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12, 14, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the camera manufacturer" in line 2. Claims 14 and 17 recite the limitation "the digital camera" in line 2. There is insufficient antecedent basis for the limitations in the claims.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-6, 8-12, and 14-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claim 1 and many of the dependents claims that depend therefrom “do not apply, involve, use, or advance the technological arts”. In the claims set forth above, the process steps can be carried out manually without applying, involving, using, or advancing the technological art. The Examiner recommends adding positive language in the body of the claim that clearly sets forth that the process steps are utilizing technology.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 10, 11, 13, and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,324,521 (hereinafter "Shiota").

Regarding **claim 1**, Shiota discloses a method of selecting a digital photographic service provider from a plurality of different service providers and providing a photographic image service with respect to at least digital image located at a user location remote from said selected photographic service provider, comprising: providing a services directory (see column 3, lines 5-10); said user providing criterion for selection of a service provider (see column 2, lines 29-33); automatically provider a list of service providers; selecting one or more service providers (see column 3, lines 5-18); providing a request for a desired service; and providing of said desired service (see column 4, lines 28-32); **[claim 2]** the criterion comprises a location of a designated recipient (see column 9, lines 17-20); **[claim 3]** the criterion includes specific product characteristics (see column 3, lines 8-10); **[claim 4]** list is accomplished through the use of a locator system (see column 2, lines 4-9); **[claim 5]** said list includes service information for each of the service providers (see column 3, lines 5-10 ); **[claim 10]** displaying a list of service providers (see column 3, lines 5-10); **[claim 11]** said criterion is directly associated with the data included in the digital image file (see column 3, lines 8-10); **[claim 13]** the service provider is positioned on a display screen according to a business criteria (see column 3, lines 8-10 ); **[claim 17]** selecting digital images digital images captured by a digital camera (see column 3, lines 31-36); **[claim 18]** the selected service is producing hardcopy prints of the selected images (see column 3, lines 31-35); and **[claim 19]** the step of selecting a print quantity for the selected images (see column 3, lines 31-36).

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Regarding **claim 20**, Shiota discloses a system for providing imaging services over a communications network as set forth above in detail for claim 1.

Regarding **claim 21**, Shiota discloses a computer software product for linking a digital camera user to a service provider selected from a plurality of service providers as set forth above in detail for claim 1.

Regarding **claim 22**, Shiota discloses a method of linking a digital photographic imaging service requester to a service provider selected from a plurality of different service providers that are registered in a member system as set forth above in detail for claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view U.S. Patent No. 5,918,054 (hereinafter "Jury").

Shiota discloses all the claimed elements as set forth above but fails to explicitly disclose use of trademark icons associated with each of the listed service providers.

Jury teaches the use of associating trademark icons with each of the providers (see column 4, lines 45-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota with the trademark icons taught by Jury, because trademark icons

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provide visual confirmation of the service provider, wherein allowing customers to better recognize a particular service provider.

9. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of U.S. Patent Application No. US 2002/0036696 (hereinafter "Takemoto").

Shiota discloses all the claimed elements as set forth above but fails to explicitly disclose use of data that includes the camera manufacturer.

Takemoto teaches the use of identifying a camera model for purposes of image processing (see ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota with camera model (manufacturer) information as taught by Takemoto, because model information allows for the elimination of an effect of a tone characteristic and color characteristic caused by a specific camera model (see ABSTRACT).

10. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Shiota in view of the Examiner's assertion of Official Notice.

Regarding claim 14, Shiota fails to explicitly disclose the use of determining the retailer of a camera to determine an image service provider.

The Examiner takes Official Notice that retailer information is old and well known data to collect when provider service on products purchased at a retail store.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota with retailer data criterion as is well known in the art, because retailers bundle products and their service/maintenance.

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Regarding claim 16, Shiota fails to explicitly disclose the use of determining a language selected by a user as business criteria.

The Examiner takes Official Notice that language criteria is old and well known in the art of electronic commerce.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota withal language data as is well known in the art, because electronic commerce over a wide area network allows user having knowledge various languages and it will be courteous to the customer to provide additional options of service.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Garfinkle et al. is cited of interest for disclosing a method of processing digital images and distributing visual prints.

Massarsky is cited of interest for disclosing a method for saving, accessing, and reprinting a digitized photographic image.

Chui et al. is cited of interest for disclosing a system for facilitating photographic print re-ordering.

Safai is cited of interest for disclosing a communicating digital images from a camera to a remote service provider.



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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

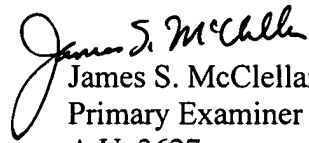
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
September 3, 2004